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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,631	10/09/2001	Gordon R. Boyes	60426-359 2001E18432US	9389

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SIEMENS CORPORATION  
INTELLECTUAL PROPERTY LAW DEPARTMENT  
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EXAMINER

BRYANT, DAVID P

ART UNIT PAPER NUMBER

3726

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/974,631

Applicant(s)

BOYES ET AL.

Examiner

David P. Bryant

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 27-29 and 31-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27-29 and 31-37 is/are allowed.
- 6) ☒ Claim(s) 38-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 3726

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over**

**Applicant's admitted prior art (AAPA) in view of Balderrama (U.S. Patent No. 5,108,524).**

AAPA is found on page 1 of the specification, where it is disclosed that an air induction assembly is typically provided with a "peel and stick" type foam gasket material. With such a gasket, a pre-manufactured gasket is provided with an adhesive backing, and is disposed on a piece of wax paper. In use, the gasket is peeled off the wax paper and applied to the desired surface of the air induction assembly. Thereafter, as is known in the art, a cover or other component of the air induction assembly is situated against the gasket to form an airtight seal.

AAPA fails to teach providing the gasket on the desired surface by applying a liquid form of thermal mastic elastomeric material thereon.

Balderrama teaches a method for applying a hot melt gasket **24** around the neck of a container prior to applying a cover **16/19** thereon. As depicted in Figures 8 and 9 and disclosed in column 2 (lines 2-10 and 36-41), a hot melt unit **27** includes a supply of hot melt material (i.e. liquid thermal mastic elastomeric material), which is heated by a heater **29** to melt and maintain the hot melt material in a molten state. Nitrogen is supplied from pressure tank **31** into the hot

Art Unit: 3726

melt material to form a foamed hot melt material. As depicted in Figures 1-3, the foamed material is fed from a nozzle 26 to a lip surface 17 of the container, and is then allowed to cure at room temperature prior to assembly of the container. As disclosed in column 1 (lines 10-52), the hot melt gasket is intended to replace pre-manufactured gaskets which often provide inadequate sealing, and which made it is necessary for a dispenser supplier to have numerous gaskets on hand of various sizes to meet the needs of its customers.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed the gasket of AAPA from foamed hot melt material, as taught by Balderrama, to provide a gasket with improved sealing ability, while obviating the need for manufacturing numerous gaskets of various sizes.

**Claims 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art (AAPA) in view of Akitomo et al. (U.S. Patent No. 5,391,336).**

AAPA is found on page 1 of the specification, where it is disclosed that an air induction assembly is typically provided with a "peel and stick" type foam gasket material. With such a gasket, a pre-manufactured gasket is provided with an adhesive backing, and is disposed on a piece of wax paper. In use, the gasket is peeled off the wax paper and applied to the desired surface of the air induction assembly. Thereafter, as is known in the art, a cover or other component of the air induction assembly is situated against the gasket to form an airtight seal.

AAPA fails to teach providing the gasket on the desired surface by applying a liquid form of thermal mastic elastomeric material thereon.

Akitomo et al. teach a method for applying a hot melt foamed gasket around the edge of a substrate 12 (typically, an automotive part, as disclosed in column 1, lines 8-12) prior to applying a top or cover thereto. As depicted in Figure 1 and disclosed in column 2 (lines 36-66), a hot melt unit 1 includes a supply of hot melt material (i.e. liquid thermal mastic elastomeric material) which is dispensed through nozzle 3 onto the gasket area of the substrate 12. Prior to dispensing, nitrogen gas is supplied through line 15 into the hot melt material to form the foamed gasket material. The foamed gasket material is then allowed to cure to form the finished gasket.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed the gasket of AAPA from foamed hot melt material, as taught by Akitomo et al., to obviate the need for manufacturing or maintaining an inventory of numerous pre-manufactured gaskets of various sizes.

#### ***Allowable Subject Matter***

Claims 27-29 and 31-37 are allowed.

#### ***Response to Arguments***

Applicant's arguments, see page 5 (lines 23-30) and page 6 (lines 1-2, 12-13, and 15-25), filed December 19, 2003, with respect to claims 27-29 have been fully considered and are persuasive. The previous rejection of claims 27-29 has been withdrawn. Since new claims 34-37 correspond closely to allowed claims 27-29 and 31-33, claims 34-37 have been allowed for similar reasons. New claims 38-40 have been rejected as set forth above.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Telephone inquiries regarding the status of this application, or other general questions, by persons entitled to the information, should be directed to the group clerical personnel. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information. M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, or fax (703) 872-9301 or by email to [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **David Bryant** whose telephone number is (703) 308-1859. Draft amendments or proposed changes to the application may be faxed directly to the examiner at any time via RightFAX at (703) 746-4213 (formal inquiries or responses should NEVER be faxed to this number). The examiner can normally be reached on **Mondays-Thursdays from 6:30 AM to 5:00 PM**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The official fax phone number for the organization where this application or proceeding is 703-872-9306 for all communications (including After Final communications).

Art Unit: 3726

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 308-6789 or (888) 786-0101
Assignment Branch	(703) 308-9723
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Petitions/Special Programs	(703) 305-9285
Terminal Disclaimers	(703) 305-8408
PCT Help Desk	(703) 305-3257

If the information desired is not provided above, or a number has been changed, please call the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	<a href="http://www.uspto.gov/">http://www.uspto.gov/</a>



David P. Bryant  
Primary Examiner  
Art Unit 3726